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| 09/773,131 | 01/31/2001 | Michel Marcel Jose Decre | PHNL000078 | 5393 |

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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| EXAMINER |
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JOLLEY, KIRSTEN

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| ART UNIT | PAPER NUMBER |
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1762

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,131

Applicant(s)

DECRE, MICHEL MARCEL JOSE

Examiner

Kirsten C Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Prosecution on the merits of this application is reopened on claims 1-8, 15, and 16 considered unpatentable for the reasons indicated below:

The indicated allowability of claims 1-8, 15, and 16 is withdrawn in view of the newly discovered reference to Nishida et al. (US 6,349,086). Rejections based on the newly cited reference(s) follow.

2. Applicant is advised that the Notice of Allowance mailed May 18, 2004 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 8, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishida et al. (US 6,349,086).

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Nishida et al. discloses a method of manufacturing a circular optical storage disc comprising: providing a substrate with a first surface and a periphery; providing a coating on the first surface by applying a liquid, rotating the substrate, and solidifying the liquid; and wherein applying the liquid onto the surface the substrate is present in a separate extension body (ring 20); the extension body having substantially circumferential contact with the periphery of the substrate, and having a surface substantially flush with the first surface of the substrate, as illustrated in Figures 12-15 and described in col. 11, lines 25-48; and after substantial solidification of the liquid, the extension body and the substrate are separated. It is known that substantial solidification of the liquid occurs in Nishida et al.'s process because solidification by UV curing occurs while ring 20 is still present around the substrate. Similarly, Applicant's own substantial solidification step is performing by UV curing while the extension body is still present around the substrate.

As to claim 2, Nishida et al. illustrates that the ring 20 is circular in Figure 12-15, and discloses that the ring has an inner diameter.

As to claim 16, Nishida et al. teaches that the UV curable resin is removed from the ring after substantial solidification of the resin and the ring is removed from the substrate (col. 11, lines 44-45).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishida et al. (US 6,349,086).

With respect to claims 3 and 4, Nishida et al. lacks a teaching that the outer periphery of the ring 20 has a polygonal, or regular polygonal, shape. It is the Examiner's position that it would have been obvious for one having ordinary skill in the art to have also used a non-circular ring/extension body, such as a square or hexagon or octagon (which are all regular polygonal shapes), with the expectation of achieving similar and equivalent results since the shape of the outer periphery of the ring/extension body is not critical to the process and would not affect the product produced, as long as the inner diameter of the ring/extension body remains the same as the outer diameter of the substrate (as taught by Nishida et al. in col. 11, lines 26-28).

With respect to claim 5, Nishida et al. lacks a teaching of the material of ring 20, or that it is substantially the same material as that of the substrate. It is the Examiner's position that it would have been obvious for one having ordinary skill in the art to have used a material for the ring that is substantially similar to that of the substrate since one would desire that the coating material flows and sticks onto the substrate and ring in the same amount and in the same manner, therefore forming a uniform coating over both surfaces. If this is not the case, and the surface of the ring has a surface where the coating material does not spread as easily as on the substrate surface, then the coating material would bead up at the edge of the substrate and negate the purpose of the ring to provide a uniform coating. Alternatively, if the surface of the ring has a surface where the coating material spreads significantly more quickly than on the substrate surface, then the coating material would be pulled from the edge of the substrate by the surface

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tension of the coating already on the surface of the ring, thus also resulting in a non-uniform coating on the substrate.

As to claim 6, Nishida et al. lacks a teaching of the material of the ring/extension body, or specifically that it comprises a material to which the coating adheres relatively poorly. It is the Examiner's position that it would have been obvious for one having ordinary skill in the art to have used a coating on the extension body where the coating material does not adhere well because then it will be easier to clean, particularly since Nishida et al. teaches cleaning the coating from the ring between each application of coating material in order to achieve subsequent uniform coatings thereon.

As to claim 7, Nishida et al. lacks a teaching of using a ring/extension body composed of at least two parts. It is the Examiner's position that it would have been obvious for one having ordinary skill in the art to have used a ring made of two (or more) parts as a matter of design preference because such a structure would not affect the process or the product produced, and because a ring composed of plural parts would be able to be more easily removed from around the substrate.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishida et al. as applied to claims 1-6, 8, and 15-16 above, and further in view of Konishi et al. (US 6,012,858).

Nishida et al. lacks a teaching of using a spin chuck/extension body which is comprised of two parts. Nishida et al. is alternatively rejected in view of Konishi et al. Konishi et al. discloses an extension body/liquid-receiving base 32 which forms a surface flush with the substrate W's surface (see Figure 6 and Figures 14A-14B, and col. 6, lines 1-7), similar to that

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used in Nishida et al. Figure 17 of Konishi et al. demonstrates that its liquid-receiving base may be formed of two parts 32a and 32b. It would have been obvious to one having ordinary skill in the art to have used a two-part ring/extension body fitted around the substrate in the method of Nishida et al., upon seeing the apparatus of Konishi et al., with the expectation of having an easier means for removal of the substrate and easier means for cleaning the extension body surfaces which are coated.

Conclusion


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nishida et al. (US 6,613,396) is also cited to for the same reasons as Nishida et al. '086 above. Nishida et al. '396 claims the use of a ring/auxiliary annular substrate in claim 2.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kirsten C Jolley
Patent Examiner
Art Unit 1762

kcj